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Paper No. 10

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**COPY MAILED**

JAN 30 2004

In re Application of  
Montoya  
Application No. 09/954,970  
Filed: September 19, 2001  
Attorney Docket No. 1187.07  
For: DUAL PIZZA PIE CONTAINER SYSTEM

**OFFICE OF PETITIONS**

DECISION DISMISSING  
PETITION UNDER 37  
CFR 1.137(a)

This is a decision on the petition under 37 CFR 1.137(a), filed January 13, 2004, to revive the above-identified application.<sup>1</sup>

Any further petition to revive the above-identified application must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Petition under 37 CFR 1.137." This is **not** final agency action within the meaning of 5 U.S.C. § 704.

This application was held abandoned for failure to timely submit a reply to the Notice to File Missing Parts of Nonprovisional Application, mailed October 19, 2001, which required petitioner to submit the statutory basic filing fee, a late filing fee, and an abstract. The Office contended that the application became abandoned on December 20, 2001 because the Office claimed it did not receive a reply. A Notice of Abandonment was mailed on November 18, 2003.

Petitioner asserts that a timely response to the October 19, 2001 Notice to File Missing Parts was deposited as first class mail on February 19, 2002. Petitioner has provided a copy of the original cover letter which states that a check in the amount of \$615, comprising a two month extension of time, a small entity basic filing fee, and a small entity late filing fee surcharge was enclosed. The copy of the cover letter has a valid certificate of mailing dated February 19, 2002 affixed thereto. A review of the application file reveals the original cover letter is present and Office financial records show that the check for \$615 was negotiated. Thus, the Office did receive a timely reply and The Notice of Abandonment was incorrect to state that no reply was received.

Unfortunately, petitioner did not submit a **complete** reply. The October 19, 2001 Notice to File Missing Parts required petitioner to timely submit fees and *an abstract* to avoid abandonment. The Office did not receive an abstract and there is no mention of an abstract on the March 6, 2002 postcard receipt.

Therefore, the application became abandoned on February 20, 2002 for failure to submit an abstract within the 2 month extended period for reply.

A grantable petition to revive an abandoned application under 37 CFR 1.137(a) must be accompanied by (1) the required reply, unless previously filed. In a nonprovisional application

<sup>1</sup> Pursuant to petitioner's authorization, deposit account no. 50-2557 will be charged a \$55.00 petition fee.

abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof; (2) the petition fee as set forth in § 1.17(l); (3) a showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unavoidable; and (4) any terminal disclaimer (and fee as set forth in § 1.20 (d)) required pursuant to paragraph (c) of this section. This petition does not satisfy requirement (3).

Regarding (3), the showing of record is inadequate to establish unavoidable delay within the meaning of 37 CFR 1.137(a). Specifically, an application is "unavoidably" abandoned only where petitioner, or counsel for petitioner, takes all action necessary for a proper response to the outstanding Office action, but through the intervention of unforeseen circumstances, such as failure of mail, telegraph, telefacsimile, or the negligence of otherwise reliable employees, the response is not timely received in the Office. Ex parte Pratt, 1887 Dec. Comm'r Pat. 31 (Comm'r Pat. 1887).

The Commissioner may revive an abandoned application if the delay in responding to the relevant outstanding Office requirement is shown to the satisfaction of the Commissioner to have been "unavoidable". 35 USC § 133. Decisions on reviving abandoned applications have adopted the reasonably prudent person standard in determining if the delay was unavoidable. Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (Comm'r Pat. 1887)(the term 'unavoidable' "is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business"); In re Mattullath, 38 App. D.C. 497, 514-15 (D.C. Cir. 1912); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (Comm'r Pat. 1913). In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account." Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982). Finally, a petition to revive an application as unavoidably abandoned cannot be granted where a petitioner has failed to meet his or her burden of establishing the cause of the unavoidable delay. Haines v. Quigg, 673 F. Supp. 314, 5 USPQ2d 1130 (N.D. Ind. 1987).

In the instant case, petitioner has failed to provide adequate evidence that the delay was unavoidable.

While petitioner asserts that an abstract has been in this file for many years, the Office has no record of receiving an abstract until January 2004.

The rules of practice are clear that prosecution of an application to save it from abandonment must include such complete and proper action as the condition of the case may require. Petitioner was provided notice that an abstract was not part of the application papers filed on September 19, 2001 in the Notice to File Missing Parts of Nonprovisional Application, mailed October 19, 2001. Petitioner was required to provide an abstract within an extendable two month period from October 19, 2001 to avoid abandonment. Petitioner did not do so. The fact that the Office did not respond to petitioner's incomplete reply does not alter the time period running against petitioner to submit an abstract. The requirement was set in the October 19, 2001 Notice and the time period for response, once properly set, would not have been reset.

The only way petitioner can prevail under an unavoidable standard is if petitioner proves that an abstract was filed upon initial filing or at latest, by February 19, 2002. If petitioner can provide an itemized Office date stamped return receipt postcard that lists "abstract" as one of the papers filed on September 19, 2001 OR any evidence that an abstract was submitted by February 19, 2002, then the petition under 37 CFR 1.137(a) will be granted.

If petitioner cannot prove that an abstract was filed upon initial filing or at latest, by February 19, 2002, then petitioner's only option to revive will be under the unintentional standard of 37 CFR 1.137(b). The current fee associated with the filing of a petition under 37 CFR 1.137(b) is \$665.00. For petitioner's convenience, a blank copy of Form PTO/SB/64: Petition for Revival of an Application for Patent Abandoned Unintentionally under 37 CFR 1.137(b) is enclosed. Further correspondence with respect to this matter should be addressed as follows:

**By mail:** Mail Stop PETITION  
Commissioner for Patents  
Post Office Box 1450  
Alexandria, VA 22313-1450  
ATTN: E. Shirene Willis

**By hand:** Crystal Plaza 1 Lobby  
2011 South Clark Place  
Room 1B03  
Arlington, VA 22202  
ATTN: E. Shirene Willis

**By FAX:** (703) 872-9306  
ATTN: Office of Petitions -- E. Shirene Willis

Any inquiries pertaining to this matter may be directed to the undersigned at (703) 308-6712.

  
E. Shirene Willis  
Senior Petitions Attorney  
Office of Petitions  
Office of the Deputy Commissioner  
for Patent Examination Policy

enclosure: blank copy of Form PTO/SB/64: Petition for Revival of an Application for Patent Abandoned Unintentionally under 37 CFR 1.137(b)